Status of the Claims

Claims 1-25, 27-29, and 31 are now pending in the present application. Claims 1, 2, 8, 9, 13, 16, 17, 19, 24, 27, 28, 29, and 31 have been amended to more clearly to define the invention. Claim 26 has been cancelled in the present amendment, and Claim 30 was previously cancelled.

The Examiner's Articulation of Applicant's Invention

In articulating his grounds for rejecting applicant's claims, the Examiner states that "according to applicant's specification, the coupons that correspond to the user's preferences are stored, then the user can further decide whether or not they want the coupons." That statement is incorrect. With respect to the statement that "*coupons that correspond to the user's preferences are stored,*" it must be noted that in applicant's invention, it is coupons that correspond to products and services for which the user has elected to receive coupons that are stored. With respect to the statement that "*the user can further decide whether or not they want the coupons,*" it must be noted that in applicant's invention, the user does not to further decide if they want a coupon. The coupons that are stored are coupons the user has *already* indicated that they want. In the set up mode, the user selects products and services for which they desire to receive coupons. Since the user has already decided they want those coupons, the user does not need to make any further decision regarding the desirability of those coupons. This fact goes directly goes to the heart of the difference between the present invention and the prior art. In the prior art, filtering coupons based on a preference profile (which is not generated for the purpose of selecting coupons for goods and services) will likely lead to the user receiving coupons that are not wanted. Thus, the received and stored coupons will need to be reviewed to remove unneeded or unwanted coupons. In the present invention, in the set up mode, the user will only select products or services to be applied in producing coupons that the user wants. As a result, the only coupons received and stored will be coupons that the user wants.

Claims Rejected under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-27, 29, and 31 under 35 USC § 103(a) as being obvious over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755). The Examiner asserts: (1) that Williams discloses a setup mode, which enables users to complete preference profiles that can be used to filter coupons; (2) that Mankovitz

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discloses a portable coupon including keys, memory, a controller and a display; (3) that Small discloses encoding and decoding data using the horizontal overscan portion of a video signal; and (4) that Terrill discloses that RAM and ROM can be used interchangeably. The Examiner appears to conclude that an artisan of ordinary skill would have been led to combine and modify these references to achieve an invention equivalent to applicant's claimed invention in order to provide a more versatile system and method for distributing electronic coupons. Applicant respectfully disagrees, particularly in view of the clarification provided by the present amendments to the claims, for the following reasons.

Applicant's independent Claims 1, 13, 24, 27, 28 29, and 31 have been amended to recite the common element (recited either as a step or as a function implemented by a processor) of enabling a user to select one or more *products or services* from a menu of products and services, to filter the coupons to be stored by the electronic coupon, such that *the selection of a product or service from the menu indicates that the user desires coupon data corresponding to the product or service selected to be stored in the electronic coupon.* Thus, when a user selects a product or service from the menu displayed to the user, the user is controlling the data that will be stored in the electronic coupon. Each selection from the menu indicates the user *wants* to receive and store data for coupons corresponding to the menu selection.

Support for the amended claims can be found in applicant's specification, which on page 8 (last paragraph) defines the menu of coupon categories as being a plurality of products and services, and which specifically states that the user selects from such a menu those products and services for which the user desires to receive and store coupons (page 8, last paragraph to page 9, first paragraph).

This argument has been previously presented. The Examiner's most recent response to this argument is that the claimed invention does not recite language corresponding to this argument. The claims have thus been amended as described above, to include such a recitation. While Williams teaches that a preference profile can be used to filter coupons, it is important to recognize that Williams does not teach or suggest that the user manipulate their preference profile specifically for the purpose of controlling the coupon data stored in an electronic coupon.

Bearing in mind that Williams is an entertainment system, consider the ways in which Williams teaches that preference profiles are established. Preference profiles can be generated by the entertainment system as it surreptitiously tracks a user's entertainment selections. It is unreasonable

1 to conclude that a user would modify viewing choices simply to control the delivery and storage of

2 coupons.

3   Williams also teaches that a user can affirmatively complete a preference profile, but is

4 absolutely silent as to how a user would perform this task. Even when a user of Williams'

5 entertainment system affirmatively completes a preference profile, there is simply no evidence that

6 Williams teaches or suggests that a user manipulate the preference profile to control the delivery and

7 storage of coupons. The context of Williams' system is very important. A user enrolls in an

8 entertainment service that delivers movies and games. The user is asked to complete a preference

9 profile in which the user is able to indicate the user's entertainment preferences, whether a user

10 enjoys sports, and the types of sports that the user enjoys, whether a user enjoys outdoor activities

11 and the type of activities that the user enjoys, what type of television programming the user enjoys,

12 the types of foods enjoyed by the user, the user's geographical location, native language, annual

13 salary, and/or profession or occupation. There is absolutely no evidence that such a user would

14 complete such a preference profile *so that the only items included in the preference profile* would be

15 products and services for which the user wanted to receive and store coupons in an electronic coupon.

16 Further, it would not be logical for a person of ordinary skill in the art to reach that conclusion based

17 upon what Williams teaches.

18   It should also be noted that Williams never teaches or suggests that a menu of products and

19 services is displayed to the user. The Examiner has asserted that because Williams discloses that the

20 entertainment system includes a GUI which "presents entertainment system with multimedia

21 identifiers (column 5, lines 14-15)," Williams necessitates the display of a menu of items that the user

22 can use to indicate likes/dislikes. That assertion is not logical. Williams states that the GUI displays

23 entertainment system data and does not state that the data displayed are a menu of items with which

24 the user interacts to establish a preference profile. A preference profile can be established by having

25 the user answer a questionnaire (i.e., a series of questions, such as is often used by dating services or

26 prospective employers to establish a personality profile). However, the art is absolutely silent as to

27 how a user would affirmatively complete a preference profile useful in connection with the present

28 invention, and the conclusion that Williams teaches completing a preference profile by displaying a

29 menu listing a plurality of items to a user so the user can select those items of interest to the user is

30 completely unwarranted. Further, even if Williams did teach displaying a menu listing interests to a

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user, there is no basis to conclude that such a menu listing interests is equivalent to a menu of products and services for which a user might want to receive coupon data. Williams explicitly states that the preference profile include items such as a user's occupation, a user's food preferences, a user's occupation, a user's native language, a user's favorite sport, and a user's entertainment preferences. Such a menu would not be relevant or equivalent to a menu of products and services displayed to a user for the purpose of enabling the user to control the coupon data that will be received and stored for use in creating coupons.

The Examiner has stated that he has decided to read the claims in light of the specification to determine the meaning of a menu of coupon categories. Applicant has amended the term "menu of coupon categories" to recite a "menu of products and services." The meaning of the term "menu of products and services" ought not be in dispute, and as indicated in MPEP 2111.01, during examination, the words of the claim must be given their plain meaning unless applicant has provided an alternative clear definition in the specification. Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Should the Examiner look to the specification, the Examiner will note that the specification states, "[I]n set-up mode, a user can scroll through a menu of products and/or services for which the user would like to receive coupons (page 8, lines 4-6)" and, "[W]hen the user finds a product or service for which the user wants to receive and store a coupon, the user can indicate this by pressing the SELECT button 218 to mark the checkbox next to the product service menu entry" (see page 8, line 25 to page 9, lines 3 of applicant's specification). These sections of the specification make it clear that in the present invention, the user only makes a selection from the displayed menu when the user wants to receive coupon data for such a product or service. The issue is not whether the user has a preference or liking for such a good or service, instead, the user makes a selected based upon a desire to receive a coupon for that product or service.

The Examiner is correct that Willams discloses checking each received coupon and only storing those coupons corresponding to the preference profile. However, the Examiner has not yet acknowledged that the process of generating a preference profile as taught by Williams is different than a user selecting products and services from a menu of products and services, specifically for the purpose of enabling the user to control the delivery and storage of data for coupons specifically

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related to those products and services.   Williams teaches establishing preference profiles surreptitiously by monitoring a user's entertainment choices, and using that preference profile to control delivery and storage of coupons. Williams also teaches a user can affirmatively generate a preference profile, by telling the entertainments system about the user.   What is missing from Williams is any teaching or suggestion that when the user generates the preference profile, the user should only include in the preference profile the specific products and services for which the user desires to receive related coupons.

Significantly, Williams assumes that if a user likes something (such as sports), then the user should receive a coupon for it. Applicant's invention recognizes that simply because a user likes sports and may watch a lot of sports programming, the user may not necessarily want to receive coupons for products or services relating to sports. Applicant's invention further recognizes that a user may want to receive coupons for a product or service that doesn't relate to a personal preference of the user (i.e., the user may need to buy tires, and thus would select that product from a menu of products and services, even though the user would not express any interest in cars, auto performance, or auto racing when completing a preference profile generated for an entertainment service). The Examiner has responded to such an argument by stating the features upon which applicant relies are not stated in the claims. The claims specifically define that selection of a product or service from the menu displayed to the user means that the user wants to receive and store coupons corresponding to the selected good or service. It is not beyond the scope of the claims to note that wanting a coupon for tires (clearly encompassed in the claim language) does not logically equate to including an interest in an activity in a preference profile related to preferences for certain activities. It is clearly unreasonable for a user to indicate an interest in watching programming related to autos, NASCAR, or other racing simply to ensure that the user receives coupons for tires.

Clearly, a user completing a preference profile for Williams' entertainment system is not equivalent to a user selecting at least one product or service from a menu displayed, so that the user is able to control the nature of the coupon data that will be received and stored on electronic coupons. Because Williams' preference profiles are not equivalent to the menu of products and services recited by applicant, and there is no teaching or suggestion in any of the cited art for modifying Williams preference profiles to achieve a menu of products and services used to control the storage of coupons, no combination of the cited references can achieve applicant's invention as claimed in independent

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Claims 1, 13, 24, 27, 29 and 31. Because dependent claims are patentable for at least the same reasons as the claims from which they depend, Claims 2-12, 14-23 and 25 are also patentable for at least these same reasons, as discussed above. Accordingly, the rejection of Claims 1-27, 29, and 31 under 35 USC § 103(a) as being obvious over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755) should be withdrawn.

Turning now to the rejection of Claims 2, 24-25, and 28, the Examiner has asserted that an electronic coupon having a housing that is inserted into a decoder having a housing is equivalent to an integral decoder. The Examiner has stated the applicant's recitation of a decoder and other elements as being disposed in a common housing is equivalent to an electronic coupon that has been placed into a port on a separate decoder. Applicant has amended Claims 2 and 24 to make it clear that the common housing is sufficiently portable so that the electronic coupon is readily transportable to a retailer, so that the coupons stored therein can be redeemed. Such a portable electronic coupon is disclosed in applicant's specification at page 10, lines 3-4, which describes that applicant's electronic coupon displays a coupon that is read by a bar scanner in a supermarket. Claim 28 has been amended to recite the step of taking the electronic coupon that includes the decoder to a retailer to redeem a coupon stored therein. The electronic coupon disclosed by Mankovitz can indeed be taken to a retailer to enable coupons stored thereon to be redeemed. However, to take the electronic coupon disclosed by Mankovitz to a retailer, the electronic coupon must first be removed from the decoder (i.e., controller 12), so that when the electronic coupon is at the retailer, the decoder is no longer in a common housing with the decoder. Mankovitz specifically suggests that the decoder/controller be incorporated into a TV or VCR (column 6, lines 19-28). Clearly, the cited art does not teach or suggest an electronic coupon that includes a decoder, so that the electronic coupon including the decoder are taken to a retailer in order to redeem coupons. There is no evidence that such a modification of Mankovitz's electronic coupon would solve any problem recognized in the art. Accordingly, the rejection of Claims 2, 24, 25, and 28 under 35 U.S.C § 103 as being obvious should be withdrawn.

Claims 9, 19, 29, and 31 each recite elements that define an invention distinguishable over the art cited by the Examiner. Specifically, each claim recites that the user must manipulate a key to place the electronic coupon in a storage mode, wherein coupons are received and filtered according to
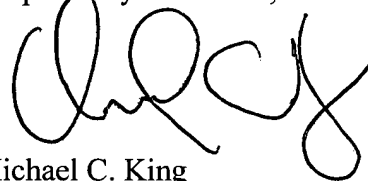
selections made by the user in the set up mode. It appears that the Examiner believes that the SAVE key disclosed by Mankovitz is equivalent to the storage mode recited by application. This belief is incorrect, because in the combination suggested by the Examiner, Mankovitz's electronic coupon would analyze each coupon based on a user's preference profile *without* the user manipulating a key (i.e., after the set up mode generates a preference profile), and when the user does manipulate the SAVE key, the coupons would not be analyzed in this combination of art. Instead, the user would merely be moving a coupon from a buffer memory to a protected memory. Once the preference profile is generated in a setup mode, Mankovitz's electronic coupon would filter all coupons received (according to Williams' preference profiles), and would store the filtered coupons in Mankovitz's first in/first out buffer. Then, the user might use Mankovitz's READ key to review the contents of the buffer, and use Mankovitz's SAVE key to move selected coupons from the buffer to the permanent memory. Significantly, according to the teaching of the prior art, once the preference profile has been generated in the set up mode, no manipulation of a key is required for filtering and storage of coupons to occur.

By comparison, in applicant's claimed invention (as defined by Claims 9, 19, 29, and 31) the user must manipulate a key to place the electronic coupon in a storage mode. When in the storage mode, the controller analyzes extracted coupon data and saves each coupon corresponding to the products and services selected by the user in the setup mode. Thus, in applicant's electronic coupon, coupons are only filtered and saved when the user manipulates a key to change the state of the electronic coupon from one of the other modes (i.e., from the set up mode or redeem mode) to the storage mode. For this additional reason, the rejection of Claims 9, 19, 29, and 31 should be withdrawn.

Claim 8 has been amended to recite that when the memory in the non-volatile memory in the electronic coupon is full, no additional extracted coupon data will be automatically stored until previously extracted coupon data are deleted. Mankovitz specifically teaches that received coupon data are directed in a buffer memory, such that when the memory is full, the oldest coupon data are written over as new coupon data are continuously received. The prior art does not teach or suggest modifying Mankovitz' electronic coupon such that the electronic coupon becomes incapable of filtering new coupons when it is full. For this additional reason, the rejection of Claim 8 should be withdrawn.

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In view of the preceding amendments and remarks, it will be apparent that all claims in this case define a novel and non-obvious invention. The application is thus in condition for allowance and should be passed to Issue without delay. Should any further questions remain, the Examiner is asked to telephone applicant's attorney at the number listed below.

Respectfully submitted,

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MCK

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, Alexandria, VA 22313-1450, on August 19, 2004.

Date: August 19, 2004

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